

REMARKS

Claims 29-48 are currently pending in this application. Claim 39 is amended. No claims are canceled or added. Figure 5 is added and the specification is amended. The amendments to the claims, drawings, and specification are supported by applicant's disclosure, e.g., at least by paragraphs [0005], [0006], and [0018], as published. No new matter is added.

In the Office Action mailed August 21, 2009, pending claims 39-41 and 46-48 were rejected. More specifically, the status of the application in light of this Office Action is as follows:

- (A) Claims 29-38 are allowed, claims 42-45 are objected to as depending from rejected base claims, and the remaining pending claims are indicated as being allowable over the art of record.
- (B) The drawings and specification are respectively objected to as allegedly failing to show certain features specified in the claims and for allegedly failing to provide proper antecedent basis for the claimed subject matter.
- (C) Claims 39-41 were rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.
- (D) Claims 46-48 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Applicant traverses the rejections and objections.

As an introductory matter, the undersigned attorney and his colleague, Rajiv Sarathy, thank Examiner Bibbins and SPE Young for their time during the Examiner Interview of August 28, 2009. During the Examiner Interview, the parties discussed the objections, the 35 U.S.C. § 101 rejection, and the 35 U.S.C. § 112 rejection.

With respect to the objections, the undersigned stated that he intended to amend the figures and the drawings.

With respect to the 35 U.S.C. § 101 rejection, Examiner Bibbins and SPE Young noted that the optical disk system of claim 39 could be performed by a computer program, thus was alleged to be non-statutory subject matter under 35 U.S.C. § 101. The undersigned stated that the applicant could add additional structural features to claim 39.

With respect to the 35 U.S.C. § 112 rejection, the undersigned indicated that the "processor-readable medium" of claims 46-48 is supported by applicant's disclosure, e.g., paragraphs [0005] and [0006], as published, as well as by the knowledge in the art at least as of applicant's priority date of October 24, 2002. Examiner Bibbins and SPE Young requested that the arguments be provided in a written response and evidence regarding the knowledge in the art be provided to the Office.

A. Allowable Subject Matter

Applicant appreciates the Examiner's allowance of claims 29-38 indication that the remaining claims would be allowable if the Section 101 and Section 112 rejections are overcome.

B. Response to the Objections

Applicant respectfully submits that the objections to the drawings and specification are moot in light of the above amendments.

C. Response to the Section 101 Rejection

Without conceding the merits of the 35 U.S.C. § 101 rejection, applicant respectfully submits that this rejection is moot in light of the claim amendments made herein, e.g., because of the additional structural features now included in independent claims 39. However, Applicant reserves the right to pursue claims in unamended or other form in this application or in continuing applications.

Applicant disagrees with a statement on pages 5-6 of the Office Action indicating that "[a]s noted by Applicant in the remarks filed on April 20, 2009, these steps are inherently performed by a computer program ('instructions') stored on a processor readable medium." (Emphasis added.) Although applicant agrees that it is inherent that features of claim 39 may be performed by a "computer program," claim 39 is not limited to only computer programs. Instead, applicant notes that the features of claim 39, and its dependent claims, can also be performed by other apparatuses or in other ways, e.g., discrete hardware, application-specific integrated circuits (ASICs), field programmable gate arrays (FPGAs), other programmable or other logic, etc.

D. Response to the Section 112 Rejection

The Office Action rejected claims 46-48 as failing to comply with the written description requirement of Section 112. Specifically, the Office Action states that phrase "processor-readable medium" is not disclosed by the specification. (Office Action, pages 4-5.)

As discussed during the Examiner Interview, and previously indicated by applicant, "[a]n objective standard for determining compliance with the written description requirement is, 'does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.'" Also, "[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." (See, MPEP § 2163.02.)

Applicant respectfully submits that the "processor-readable medium" referenced by claims 46-48 is supported by applicant's disclosure, e.g., paragraphs [0005] and [0006], as published, as well as by the knowledge in the art on applicant's priority date of October 24, 2002.

As requested by Examiner Bibbins and SPE Young, the undersigned is providing two documents illustrating knowledge in the art on applicant's priority date. The

undersigned also notes that there are many additional examples of such knowledge, but considers them to be redundant to the two provided documents. Attached hereto as Appendix B is a press release published on August 2, 2001, retrieved from <http://www.hitachi.com/New/cnews/E/2001/0802/0802.pdf>. This press release discusses a microcontroller "suitable for control of storage devices such as CD-R/RW and DVD-ROM/RAM[.]" (Page 1.) This press release also states that the microcontroller has a "large 512-Kbyte flash memory and a 16-Kbyte RAM[.]" (Page 1.)

Attached hereto as Appendix C, is a December 18, 2001, EE Times article retrieved from <http://www.design-reuse.com/articles/?id=2267&print=yes>. This article states that "[t]his block typically incorporates functions such as an MPEG-2 video decompressor, a DSP, a 32-bit microprocessor, I/O for audio, infrared for control and a built-in TV encoder or digital video output for a TV encoder." (Page 1, emphasis added.) In addition, "[t]ypically, SDRAM is used as a data and program store for the processor, DSP and other functional blocks. Flash is used to store program and persistent data." (Page 1.)

As illustrated by the two attached documents and quoted above, one of ordinary skill in the art would clearly recognize that processors (e.g., DSPs, microprocessors, microcontrollers, etc.) and processor-readable media (e.g., flash, RAM, SDRAM, etc.) were commonly employed in optical devices and optical disk systems such as the "optical device" of paragraph [0005] and the "optical disk system" of paragraph [0006].

For at least these reasons, applicant's disclosure readily conveys, to one of skill in the art, that the applicant was in possession of the "processor-readable medium" of claims 46-48.

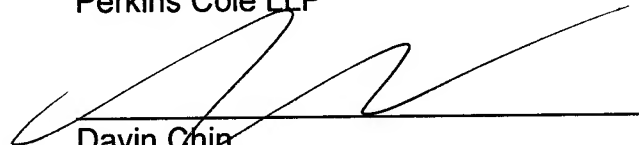
For at least the reasons discussed above, applicant respectfully requests that the Section 112 rejection be withdrawn.

Conclusion

In view of the foregoing, the pending claims comply with the requirements of 35 U.S.C. §§ 101 and 112. Applicant does not concede any rejection not specifically responded to above, and reserves its rights to respond to any such rejections later. Applicant accordingly requests reconsideration of the application and a mailing of a Notice of Allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact Davin Chin at (206) 359-8000.

Respectfully submitted,
Perkins Coie LLP

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Appendix A